

## **REMARKS**

### **Allowable Claims**

Applicant acknowledges and thanks the Examiner for finding that claims 1-8, 10 and 12-14 are allowable.

### **Amendments to the Claims**

Applicant has divided the alternative embodiments of claim 15 in two. The second embodiment of claim 15 can now be found in claim 21. Applicant has done the same for claim 16. The second embodiment of claim 16 can now be found in claim 22. It will be appreciated that no new matter has been added and that the overall scope of the claims remains unchanged. These amendments are made without prejudice, without intent to acquiesce in any rejection of record, and without intent to abandon any originally claimed subject matter.

### **Novelty rejection of new claims 21-22 in view of Herbert (US 6,102,592)**

As noted, new claims 21-22 have been added that correspond to the second embodiments of claims 15-16, respectively. Thus, claim 21 relates to a method of preparing copy proof paper wherein the paper includes first and second markings that are metameretic and have a *different* color appearance under copier light. Claim 22 relates to the copy proof paper itself.

Herbert does not teach the method of claim 21 or the copy proof paper of claim 22. More specifically, the methods of Herbert do not include each and every step of claim 21 and cannot therefore anticipate claim 21. Similarly, the paper of Herbert does not include each and every element of claim 22 and cannot therefore anticipate claim 22. MPEP § 2131.

First, claims 21 and 22 both require the first and second colored markings to have a *color appearance* under copier light. One of the markings on the paper taught by Herbert becomes *invisible* under copier light. Applicant respectfully submits that a skilled person would recognize that an *invisible* marking does not have a *color appearance*. It has no appearance.

Second, claims 21 and 22 also require the first and second colored markings to be *metameretic*. As noted in the specification (see pp. 2-3), the term “metameretic markings” refers to a pair of colored markings that have the *same* color appearance under one light condition but not another. Even if it were true that an “invisible” marking has a color appearance (which Applicant does not concede), Herbert does not teach a pair of colored markings that

have the *same* color appearance under one light condition but not another. Indeed, nowhere does Herbert teach or suggest that the two markings should have the *same* color appearance under a given light condition. Herbert only teaches that one of the markings should become invisible under copier light.

For all of these reasons, Applicant respectfully submits that new claims 21-22 are not anticipated by Herbert. Withdrawal of this rejection is earnestly requested.

**Novelty rejection of amended claims 15-16 in view of Herbert (US 6,102,592)**

The novelty rejection over Herbert is also traversed as applied to amended claims 15-16, reconsideration is respectfully requested.

As amended, claim 15 relates to a method of preparing copy proof paper wherein the paper includes first and second markings that are metameric and have the *same* color appearance under copier light. Claim 16 relates to the copy proof paper itself.

The arguments that were made above regarding claims 21-22 also apply here. In addition, Applicant notes that even if it were true that an “invisible” marking has a color appearance (which Applicant does not concede), the methods of Herbert would not read on claims 15-16 since the markings of Herbert are “visible” and “invisible” under copier light and thus would not have the *same* color appearance under copier light. It would appear that the Examiner has recognized this aspect of Herbert since the Office Action states “Herbert teaches a method of preparing a copy-proof article [wherein] the first and second markings have a *different* color appearance (i.e., visible vs. invisible) under copier light” (*emphasis added*).

For all of these reasons, Applicant respectfully submits that amended claims 15-16 are not anticipated by Herbert. Withdrawal of this rejection is earnestly requested.


**Conclusion**

Based on the above, Applicant respectfully requests that the Examiner reconsider and withdraw all outstanding rejections and objections. Favorable consideration and allowance are earnestly solicited. Should there be any questions after reviewing this paper, the Examiner is invited to contact the undersigned at 617-248-4793. It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required for consideration of this paper

(including fees for net addition of claims) are authorized to be charged in two copies of an Amendment Transmittal Letter filed herewith.

Respectfully submitted,  
CHOATE, HALL & STEWART

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